

### REMARKS

The Applicants do not believe that examination of the forgoing will result in the introduction of new matter into the present application for invention. Therefore, the Applicant, respectfully, requests that the above amendment be entered in and that the claims to the present application, kindly, be reconsidered.

The Final Office Action dated March 11, 2005 has been received and considered by the Applicants. Claims 1-20 are pending in the present application for invention. Claims 1-20 are rejected by the Final Office Action dated March 11, 2005.

The Examiner made the March 11, 2005 Office Action final based on the assertion that Applicant's amendment necessitated a new ground(s) of rejection. The Applicant hereby asserts the finality of the March 11, 2005 Office Action is premature. The MPEP §706.07 details when a Final Rejection is proper on second action.

"Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)."

The March 11, 2005 Office Action includes a rejection of Claims 1, 5, 8 and 9 under the provisions of 35 USC §112, second paragraph. There was no rejection of Claims 1, 5, 8 and 9 under the provisions of 35 USC §112 in the previous office action. The terms that are the subject of the rejection of Claims 1, 5, 8 and 9 under the provisions of 35 USC §112 existed within these claims before the previous amendment submitted November 6, 2004 by the Applicants. Therefore, the rejection of Claims 1, 5, 8 and 9 under the provisions of 35 USC §112, second paragraph constitutes a new rejection that was not necessitated by any action on the part of the Applicants. The previous amendment submitted November 6, 2004 by the Applicants amended Claim 1 and 9, however, the terms "associated user", "said terminal" and the terminal" existed within Claims 1 and 9 before the previous amendment submitted November 6, 2004 by the Applicants. There was no amendment ever made by the Applicants to Claims 5 and 8, therefore, the rejection to Claims 5 and 8 under the provisions of 35 USC §112, second paragraph constitutes a new rejection that was not necessitated by any action on the part of the Applicants.

Therefore, the holding of finality for the March 11, 2005 Office Action is premature, at least regarding Claims 1, 5, 8 and 9.

The March 11, 2005 Office Action contains a provisional obviousness-type double patenting rejection to Claims 1 and 9. The previously submitted amendment by the Applicants on November 6, 2004 amended Claim 1 and 9; however, this amendment was not a broadening amendment. Therefore, there is no reason why this provisional obviousness-type double patenting rejection to Claims 1 and 9 should not have been made sooner. Accordingly, the holding for finality of the March 11, 2005 Office Action is premature, at least regarding Claims 1 and 9.

The Applicant, respectfully, requests that the Primary Examiner reconsider the holding of finality of the March 11, 2005 Office Action and withdraw the finality of the March 11, 2005 rejection.

The foregoing amendment to the claims has been made to fully respond to a Final Office Action, which finality is fully anticipated to be withdrawn because it is premature. The Applicant, therefore, reasonably anticipates an opportunity to respond to a non-final office action, which response may include the rescinding of the changes made by the foregoing amendment.

The Office Action rejects Claims 1, 5, 8, 9, 11, 12, 13, 16 and 20 under the provisions of 35 USC §112, second paragraph. The Applicants, respectfully, point out that each of the items mentioned in this rejection has been corrected by the foregoing amendment to the claims.

The Office Action objects to Claims 1, 9 and 20. The Applicants, respectfully, point out that each of the items mentioned in this objection has been corrected by the foregoing amendment to the claims.

The Final Office Action rejects Claims 1, 9 and 12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 15 of U. S. Patent No. 6,778,826. The Final Office Action provisionally rejects Claims 1, 9 and 12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 12 of U. S. Patent Application No. 09/833,471. The Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other.

The Applicants, respectfully, request that the rejection of Claims 1, 9 and 12

under the judicially created doctrine of obviousness-type double patenting and provisional double patenting be rescinded for the following reason. U.S. Patent No. 6,778,826 and U. S. Patent Application No. 09/833,471 are commonly owned with the present application for invention and were pending upon filing of the present application for invention. Therefore, the claims to U.S. Patent No. 6,778,826 and U. S. Patent Application No. 09/833,471 can be used as a basis for a double patenting rejection, but these claims cannot be treated as prior art. In making the aforementioned obvious-type double patenting rejection, the Examiner inherently states that the rejected claims to the present invention differ from that of that of U.S. Patent No. 6,778,826 and U. S. Patent Application No. 09/833,471 because, simply put, a same-invention, double patenting rejection has not been made. The Final Office Action alleges that the claims to the present invention are obvious in view of the claims to U.S. Patent No. 6,778,826 and U. S. Patent Application No. 09/833,471, however, the Examiner has cited no prior art, whatsoever, showing that the differences between the rejected claims of the present invention and the claims to U.S. Patent No. 6,778,826 and U. S. Patent Application No. 09/833,471 amount to an obvious modification of the claims to U.S. Patent No. 6,778,826 and U. S. Patent Application No. 09/833,471. Without a prior art recitation to substantiate an obvious-type double patenting rejection, there is no factual basis upon which the assertion of obviousness can be measured. Therefore, this double patenting rejection cannot stand. The foregoing analysis is clearly the rule regarding obvious type double patenting rejections and is a synopsis from a decision before the Board of Patent Appeals And Interferences, Appeal No. 1998-0425, Ex parte Frank L. Schmit, Lloyd Ewing and David T. Redmon, Application No. 08/272,527, pages 4-5.

Accordingly, the rejection of Claims 10-24, 31, 32, 35, 36, 40, and 42 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims U.S. Patent No. 6,778,826 and U. S. Patent Application No. 09/833,471, is respectfully, traversed.

The Office Action rejects Claims 1, 2 and 9 under the provisions of 35 U.S.C. §102(a) as being anticipated by European Pub. No. EP 0 888 025 A2 by Amin (hereinafter referred to as Amin) for the reasons stated in the PCT International Search Report for International Application No. PCT/EPO1/04026.

As stated in the MPEP §2131, a "claim is anticipated only if each and every

element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Applicants, respectfully point out that the rejected claims define subject matter for networked communications comprising at least one server and a plurality of user stations each having a terminal that can receive information from the server via a first network. Additionally, the rejected claims define subject matter for storing a profile database containing data representing a characteristic behavior of an associated user terminal network address or addresses, the data being acquired automatically in response to an activity of the associated user and stored with the associated user network address in the profile database. The rejected claims still further define subject matter for the user station having a portable communications device coupled to the terminal and connectable to the server via a second network that is independent of the first network, wherein the coupling between the portable device with the terminal is by wireless transmission, and the portable communications device includes means for receiving wireless transmissions from the terminal are further configured to receive additional data transmitted wirelessly from other sources than said second network.

The Applicants would like to, respectfully, point out that the PCT International Search Report refers to the Abstract; col. 2, lines 34-39; and col. 3 lines 48-col. 4, line 31 of Amin.

The Abstract of Amin discusses a wireless communication system with a wireless switch that includes a partition table that associates a service provider to each wireless terminal. There is no disclosure, or suggestion, within Amin for the terminal of any user station coupled to a portable communications device that can connect to the server via a second network that is independent of the first network.

The Applicants further point out that col. 2 lines 34-39 of Amin simply states that upon receipt of a service request from a wire-less terminal, the switch looks up the subscriber profile and provides telecommunication services for the subscriber. Amin does not disclose or suggest that the wireless terminal is in any way connected to a second network that is independent of the first network. Furthermore, Amin does not disclose or suggest a profile database containing data acquired automatically in response to an activity of the associated user and stored with the associated user network address in the profile database.

The Applicants further point out that col. 3, lines 48-col. 4, line 31 of Amin discusses that mobile stations 102, 104 can interface with mobile switching center. Amin does not disclose or suggest that either of mobile stations 102, 104 is in any way connected to a second network that is independent of the first network. Simply put, mobile stations 102, 104 as taught by Amin can interface with mobile switching center, however, mobile stations 102, 104 can not communicate with each other, e.g. there is only a single network.

In view of the foregoing discussion, Amin does not anticipate the rejected claims. The Applicants respectfully point out that the PCT International Search Report is only a search report and it readily appears that PCT International Search Report was in error for citing Amin as a reference that anticipates the rejected Claims. Therefore, this rejection is, respectfully, traversed.

The Office Action rejects Claims 1-5, 9 and 11 under the provisions of 35 U.S.C. §103(a) as being unpatentable over Intl. Pub. No. WO 99/33293 by Dennis (hereinafter referred to as Dennis) in view of European Pub. No. EP 0944 002 by Bunney et al. (hereinafter referred to as Bunney et al.).

The Examiner states that Dennis teaches a networked communications apparatus comprising at least one server and a plurality of user stations, wherein the user stations comprise terminals which can receive information from the at least one server by means of a connection via first network. The Examiner's position is that Dennis teach a user station having a portable communications device coupled to a terminal and connectable to the server via a second network that is independent of the first network, wherein the coupling between the portable device with the terminal is by wireless transmission, and the portable communications device includes means for receiving wireless transmissions from the terminal are further configured to receive additional data transmitted wirelessly from other sources than said second network.

The Applicants, respectfully, disagree. Dennis teaches a terminal 101 linked to a wireless network 103 through the internet. As the Examiner points out, page 8, lines 18-20 of Dennis states that the terminal could connect directly to the wireless network 103. The Applicants respectfully, point out that the foregoing does not reach all the elements of the rejected claims. The service control point of Dennis is equivalent to the server of the rejected claims. The wireless device 106 of Dennis is equivalent to the portable communications device of the

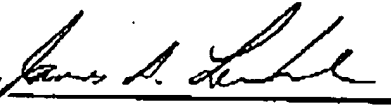
rejected claims. There is no disclosure, or suggestion, within Dennis for any connection to exist between the wireless device 106 and the terminal 101. The Applicants, respectfully, submit that the rejected claims are clearly allowable over the combination of Dennis in view of Bunney et al.

The Office Action rejects Claims 6-8 and 10 under the provisions of 35 U.S.C. §103(a) as being unpatentable over Dennis in view of Bunney et al., and further in view of U.S. Pub. No. 2002/01220612 in the name of Martin et al. (hereinafter referred to as Martin et al.). The Examiner admits that the combination of Dennis with Bunney, et al. does not disclose the subject matter of Claim 6 for a buffer arranged to receive and store said additional data transmitted wirelessly. The Examiner's position is that Martin et al. provide this missing element. As previously discussed, combination of Dennis with Bunney, et al. does not disclose a second network wherein a portable communications device provides an interface with the user terminal and the server. The buffer defined by Claim 6 receives and stores additional data transmitted wirelessly from other sources than said second network. Therefore, all the elements of rejected Claim 6 are not found by the combination made in the Final Office Action. Claims 7, 8 and 10 also define subject matter for a second network wherein the portable communications device provides an interface with the user terminal and the server. Therefore, this rejection is, respectfully, traversed.

Applicant is not aware of any additional patents, publications, or other information not previously submitted to the Patent and Trademark Office which would be required under 37 C.F.R. 1.99.

In view of the foregoing amendment and remarks, the Applicant believes that the present application is in condition for allowance, with such allowance being, respectfully, requested.

Respectfully submitted,

By 

James D. Leimbach  
Patent Attorney Reg. No. 34,374

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James D. Leimbach